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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6 *Ex Parte* HIROYUKI NISHII and HIROAKI MASHIKO

7
8 Appeal 2009-015217
9 Application 09/809,273
10 Technology Center 1700

11 Oral Hearing Held: June 17, 2010

12
13 Before MICHAEL P. COLAIANNI, BRADLEY R. GARRIS, and
14 BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

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16 APPEARANCES:

17 ON BEHALF OF THE APPELLANT:

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1 THE USHER: Calendar No. 50, Appeal No. 2009-015217,

2 Ms. Sengupta.

3 JUDGE COLAIANNI: Good afternoon.

4 MS. SENGUPTA: Good afternoon, Your Honors.

5 JUDGE COLAIANNI: Welcome to the Board.

6 MS. SENGUPTA: Thank you.

7 JUDGE COLAIANNI: You'll have 20 minutes to make your

8 arguments.

9 MS. SENGUPTA: Yes, Your Honor.

10 JUDGE COLAIANNI: If you have a business card for the Court
11 Reporter, it would be appreciated.

12 MS. SENGUPTA: Yes --

13 COURT REPORTER: Oh, sorry. Thank you.

14 MS. SENGUPTA: Do you need one for the bench?

15 COURT REPORTER: Do you want one?

16 MS. SENGUPTA: Do you want one for the bench?

17 JUDGE COLAIANNI: Oh, no, no. All right. Thank you. You may
18 begin whenever you're ready.

19 MS. SENGUPTA: Thank you -- Your Honors. My name is Deb
20 Sengupta here on behalf of the Appellants, Nishii, et al, in Application No.
21 09/809,273. There are three rejections currently on appeal, one rejection
22 under Section 102(b) and two under Section 103(a). I will first address the
23 rejection under 102(b) because that may address the subsequent 103(a)
24 rejections as well.

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1 Independent Claim 4 is rejected under 35 U.S.C., Section 102(b) as
2 allegedly being anticipated by Wakamatsu, which is a U.S. patent. And the
3 rejection is based on a molded cuplike plastic container, which is disclosed
4 in Wakamatsu, whereas in the Independent Claim 4, which is under
5 rejection, what is being claimed is two sheets, which are flat sheets and are
6 joined on the periphery, along the periphery. Therefore, Wakamatsu does
7 not disclose this flat sheet structure that is claimed currently.

8 The Examiner has maintained that Wakamatsu does indeed teach the
9 presently claimed invention because the claim recites "made of a flat sheet."
10 But the claim is read in light of the specification and especially the figures,
11 which show that the presently claimed invention are two sheets which are
12 joined together. Wakamatsu does not disclose or suggest each and every
13 element of the present claims.

14 JUDGE GARRIS: Let me ask you why you bring -- since you're on
15 that issue --

16 MS. SENGUPTA: Yes, Your Honor --

17 JUDGE GARRIS: I believe the Examiner refers to Figure 1 of your
18 drawing as showing that these --

19 MS. SENGUPTA: Yes, Your Honor --

20 JUDGE GARRIS: -- the member that you're claiming does indeed
21 include a sheet which is not flat, but which has -- it may have originally been
22 flat, but it has been shaped into something of a cup shape itself --

23 MS. SENGUPTA: Yes, Your Honor.

24 JUDGE GARRIS: -- and so the Examiner is saying that the claim
25 recitation "wherein said container is made of two flat sheets," even when
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1 read in light of the specification, would include a container wherein the two
2 sheets have been shaped to be cuplike, as shown in Figure 1, or as shown in
3 Wakamatsu. How do you respond to that?

4 MS. SENGUPTA: Yes, Your Honor. Respectfully, Figure 1 is a
5 prospective view of what is actually Figure 2. And if we look at Figure 2 of
6 the application, that shows the actual claimed invention, or claimed member,
7 is a flat structure. Figure 1 is only a very zoomed in view of what is Figure
8 2, and it has a little bit of a bulge because when you put in the removing
9 agent between the two sheets, it may change shape a little bit, but overall, it
10 is still two flat sheets which are joined together and sealed at the sides.

11 If you remove that removing member, the sheet again becomes flat,
12 and especially in Figure 2, it clearly shows that there may be a slight
13 bulging, but it's -- overall, it is still a flat structure. It's two flat sheets, which
14 are joined together. And this is not possible in Wakamatsu because
15 Wakamatsu is a blister-molded cuplike plastic container. And a cuplike
16 plastic container cannot -- is not a flat structure. And whether you have to
17 removing the removing agent inside or outside the cup, it still retains its
18 molded cuplike structure.

19 JUDGE GARRIS: Are you saying that your claimed invention in this
20 case --

21 MS. SENGUPTA: Yes, Your Honor --

22 JUDGE GARRIS: -- would not include any such cuplike shape,
23 regardless of whether the removing agent is present or not?

24 MS. SENGUPTA: Yes, Your Honor. If you look at the claim
25 language, it says that the container is made of two flat sheets which are

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1 joined together only at the peripheries. And therefore, the container contains
2 two flat sheets, which are joined together rather than a cuplike structure.

3 JUDGE GARRIS: Well, again, I have to emphasize that the claim
4 does not require that the container consists of two flat sheets that had no
5 shape to them. It doesn't require that the container itself be flat, only that the
6 container be made of, or constructed of, two sheets --

7 MS. SENGUPTA: Two flat sheets.

8 JUDGE GARRIS: -- which may have originally begun as flat
9 sheets --

10 MS. SENGUPTA: Yes, Your Honor.

11 JUDGE GARRIS: -- but which have been shaped in the process of
12 making the container. That is the Examiner's position. Of course, the
13 Examiner cites to Figure 1 of the drawing as supporting that position. And I
14 think you have said here that you agree that there is at least a bulge shape
15 shown in Figures 1 and 2.

16 MS. SENGUPTA: Yes, Your Honor.

17 JUDGE GARRIS: So I would ask you to also look at Figures 4 and 5.
18 That represents an alignment where the lower sheet, in fact, has been shaped
19 into a cuplike configuration. That would be Element 13. That's the lower
20 sheet. And they had originally been flat, but it has been made into
21 something more in the form of a cuplike container, just as is disclosed by
22 Wakamatsu.

23 MS. SENGUPTA: I agree, Your Honor, that Figures 4 and 5 show
24 this cuplike structure, but arguably, this is a non-elected embodiment
25 possibly, that is --

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1 JUDGE GARRIS: I'm not asking you what's possible. What I'm
2 asking you -- if part of your invention includes the embodiment of Figures 4
3 and 5, then what is it in Claim 4 that you imply is excluded -- excludes these
4 Figures 4 and 5. These figures seem to support the Examiner's interpretation
5 of Claim 4, and I'm asking you why that is not the case.

6 MS. SENGUPTA: During the prosecution of this application, I
7 believe the claims were amended specifically to overcome prior art, which
8 may have included this cuplike structure. The claims were specifically
9 amended to recite this flat sheet in order to overcome these rejections, prior
10 rejections, and so --

11 JUDGE GARRIS: Well, the issue before us is whether in fact that
12 language, flat sheets, does indeed distinguish over the Wakamatsu reference.
13 And I have to tell you that I did observe and you agreed that you in fact
14 referred to Figures 4 and 5 in describing your claims before us on this
15 Appeal. So it seems to me that the claims you have presented to us by your
16 own discussion of them must include the embodiment that is shown in these
17 figures.

18 MS. SENGUPTA: Your Honor, may I please ask which paragraph in
19 the Appeal Brief you're referring to, where we discuss Figures 3 and 4?

20 JUDGE GARRIS: It's Figures 4 and 5 I'm talking about --

21 MS. SENGUPTA: 4 and 5? I'm sorry.

22 JUDGE GARRIS: On Page 6 of your Brief, in the summary of the
23 claimed invention, you specifically refer to all figures, 1 through 6, as well
24 as 4 through 6, in both of the paragraphs which discuss --

25 MS. SENGUPTA: I see, Your Honor.

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1 JUDGE GARRIS: -- Claim 4 as well as the paragraph that discusses
2 Claim 10.

3 MS. SENGUPTA: Um-hum. Your Honor, I do apologize. I could
4 look into this a little further and look back at the prosecution and address
5 this matter if you would like in a Supplemental Brief.

6 JUDGE GARRIS: No. I don't think we're prepared to request a
7 Supplemental Brief on this issue. It's really the same issue that has been
8 presented --

9 MS. SENGUPTA: Yes, Your Honor.

10 JUDGE GARRIS: -- before the Examiner and in your Original Brief.
11 We're just trying to flush out the scope of the issue and the evidence that
12 supports the Examiner's position --

13 MS. SENGUPTA: Yes, Your Honor.

14 JUDGE GARRIS: -- and the evidence that supports your position. Is
15 there anything else you would care to present to us during the oral
16 argument --

17 MS. SENGUPTA: No. This --

18 COURT REPORTER: Excuse me.

19 MS. SENGUPTA: I'm sorry.

20 COURT REPORTER: Can you try not to talk over him. I'm having a
21 hard time hearing him.

22 MS. SENGUPTA: I apologize. Sorry.

23 COURT REPORTER: Thank you.

24 MS. SENGUPTA: Your Honor, at this time, our main argument is
25 that the amended claims, as amended currently, recite the flat sheets, and the
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1 claimed invention is a flat member, which does not read on the cuplike
2 molded material of Wakamatsu.

3 JUDGE GARRIS: I have no further questions.

4 JUDGE COLAIANNI: Judge Franklin? Thank you.

5 MS. SENGUPTA: You're welcome.

6 Whereupon, the proceedings, at 1:36 p.m., were concluded.

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